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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,589	02/12/2001	Luis Rafael Herrera Estrella	TJK/137	5829

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EXAMINER

LU, FRANK WEI MIN

ART UNIT PAPER NUMBER

1634

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/701,589	HERRERA ESTRELLA, LUIS RAFAEL	
	Examiner	Art Unit	
	Frank W Lu	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 17, 27, 32, 37, 47, 57, 67, 74, 80, 91, 93, 98, 99, 103-107 and 127-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) see above are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's response to the office action filed on December 28, 2002 has been entered. In page 1 of applicant's remarks, applicant states "[C]ANCEL Claims 2-7, 8-11, 12-16, 18-26, 38-46, 48-56, 58-66, 68-79, 81-90, 94-97, 100-102, 108-121, 130-131, and 133-138." while, in page 5, first paragraph of applicant's remarks, applicant states that "allowable claims 18, 28, 38, 48, 58, 68, and 100 have been canceled as being duplicative of a pending allowable claim.", this indicates that claims 28 and 74 has been canceled and claims 29-36 and 103-107 are still pending. However, in page 4, fourth paragraph of applicant's remarks, applicant states "[F]ollowing the entry of this amendment, the claims indicated as allowable are pending: 1, 17, 27, 37, 47, 57, 67, 74, 80, 91, 93, 98-99, and 127-129 are pending.". Although these different statements on applicant's remarks do not correspond each other, since claims 2-5 and 8-10 have been canceled while claims 29-31 are dependent on canceled claims 8-10 and claims 33-36 are dependent on canceled claims 2-5, the examiner assumes that claims 29-31 and 33-36 have been canceled and claims pending in this application are claims 1, 17, 27, 32, 37, 47, 57, 67, 74, 80, 91, 93, 98, 99, 103-107, and 127-129.

### ***Election/Restriction***

2. Based on reviewing pending claims 1, 17, 27, 29-37, 47, 57, 67, 74, 80, 91, 93, 98, 99, 103-104, and 127-129, the examiner notes that these claims are directed to different inventions

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which are not restricted previously. Therefore, restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1, 17, 27, 32, 37, 47, 57, and 67, drawn to a method for obtaining transgenic plants.

Group II, claims 74, 80, and 91, drawn to a recombinant heterologous DNA molecule.

Group III, claims 93, 98, 99, 103-107, and 129, drawn to transgenic plants (claims 93, 98, 99, and 103-107) and transgenic seeds (claim 129).

Group IV, claims 127 and 128, drawn to use of transgenic plants.

2. The inventions listed as Groups I to IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, the technical features linking Groups I and II are not special since a recombinant heterologous DNA molecule recited in claim 74 of Group II is known in the art (see abstract in Gallardo et al., *Planta*, 197, 324-332, 1995).

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Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, step a) of claim 1 in Group I is not required for Group III.

Groups I and IV do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, step a) of claim 1 in Group I is not required for Group IV.

Groups II and III do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, a transgenic plant of claim 98 in Group III is not required for Group II.

Groups II and IV do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, a transgenic plant of claim 127 in Group IV is not required for Group II.

Groups III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. For example, a soils of claim 127 in Group IV is not required for Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Note that Claim 127 or 128 provides for the use of transgenic plants, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

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applicant is intending to encompass. The claims 127 and 128 are indefinite where they merely recite a use without any active, positive steps delimiting how this use is actually practiced.

Claim 127 or 128 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

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Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

A handwritten signature in cursive script, appearing to read 'Frank Lu'.

Frank Lu  
August 8, 2003